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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,099	03/16/2005	Hidemichi Ishikawa	U 016916-3	5843
140 7590 10/07/2009 LADAS & PARRY LLP 26 WEST 61ST STREET NEW YORK, NY 10023				
EXAMINER LOPEZ, CARLOS N				
ART UNIT 1791		PAPER NUMBER		
NOTIFICATION DATE 10/07/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nyuspatactions@ladas.com

Office Action Summary

Application No.

10/528,099

Applicant(s)

ISHIKAWA ET AL.

Examiner

CARLOS LOPEZ

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-25 is/are pending in the application.
- 4a) Of the above claim(s) 6-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tang (US 6,274,080) in view of Applicant's admitted prior art in the first full paragraph of the specification at page 8 (PAT). Tang discloses a method of making ceramic compositions for sanitary ware having the appearance of granite or marble structures. (Col 8, lines 22ff). The composition provides agglomerates having an average particle size of 2-5mm. (Col 7, lines 45ff). The agglomerates are obtained by mixing ceramic fine powder with water and then spray drying or dewatering the agglomerated ceramics. (col. 7, lines 15ff)

As shown in example 1/1A the ceramic powder is added to a beaker containing water, the mixture is then processed to form agglomerates with the noted particle size and eventually the agglomerated ceramic particles are dried. As the agglomerated ceramic particles are dried, hence reach a water content of zero percent, the agglomerated ceramic would at some time during the drying process have the claimed 0 to 25% water content. Tang is silent disclosing the particle size of the ceramic fine powder that would form the agglomerates when making sanitary ware.

However, PAT provides that "the agglomerate has a 50% average particle diameter of 1 to 15 on a number basis. This particle diameter distribution corresponds to

the particle diameter distribution which is commonly possessed by a slurry for a sanitary ware body". Therefore, while Tang fails to disclose the size of the ceramic fine powder that is added to the water that would form the sanitary ware, PAT provides that the claimed powder sizes are conventional sizes used in order to form sanitary ware. Hence, at the time the invention was made it would have been obvious to a person of ordinary skill in the art to have used the disclosed ceramic fine particle sizes as taught by PAT in order to obtain a sanitary ware as sought by Tang having the appearance of granite or marble.

Consequently, what Tang teaches is a general process for making agglomerated ceramic particles that may be used to make sanitary ware for which PAT provides the additional modifications that a person of ordinary skill in the art would make in order to form desired sanitary ware.

Sanitary ware is normally made by a slip casting method¹, support for this premise is shown in the notice of reference cited 9/17/08 disclosing patents making sanitary ware products such as toilets bowls using a slip casting method. Thus, the industry uses slip casting in making sanitary ware. Consequently if Tang teaches of using the non-slurry composition for sanitary ware, it would naturally follow that the process employed to make the sanitary will be slip casting in accordance with industry practice. Hence, the non-slurry composition disclosed by Tang is deemed as capable of being used in a slip casting process.

¹ Contrary to applicant's assertion that Tang makes sanitary ware using the press molding method.

As for claim 25, the obtained agglomerated particles may then be compacted and grinded. Thus, the grinding of the compacted agglomerated particles would result in the claimed "flakes."

In regards to claims 26-27, it is deemed that the additional steps recited by Tang in view of the admitted prior art does not materially change the invention. In the end, Tang like applicant would both obtain a sanitary ware product.

In accordance with MPEP 2111.03, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." Furthermore, as noted in MPEP 2111.03 it is an **applicant's burden to establish that a step practiced in a prior art method is excluded from his claims by consisting essentially of language.** Here, Tang discloses one slurry composition having no polymer, see bridging paragraph of Col. 3-4, and Tang also disclose an alternative embodiment where the slurry composition comprises a polymer. Hence, it appears that applicant may have established that the second embodiment of Tang "materially changes" the claimed invention but it has failed to address the first embodiment of the non slurry composition not having any polymers.

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are unpersuasive. Applicant's contention is that Tang's non-slurry composition relates to press molding and not to the claimed slurry "capable" of slip casting.

Applicant cites Col. 1, lines 28-40 to support his argument that Tang composition is drawn to press molding processes and not slip casting as instantly claimed.

However, Col. 1, lines 28-40 provides that press molding process is for the formation of ceramic tiles. Hence, Applicant is correct that Tang provides a non-slurry for press molding but a more accurate characterization² provides that such press molding process is reserved for making ceramic tiles.

Tang not only discloses the making of ceramic tiles but also discloses the use of the non-slurry for making sanitary ware which the industry **does not normally use a press molding process but rather a slip casting method.** Applicant is invited to refer to the references cited of record which clearly show that when making a sanitary ware it is normally industry standard to do so using a slip casting method and **not the alleged press molding process.**

In conclusion Applicant's argument on the basis that Tang is drawn to slurry composition for press molding processes is both unpersuasive and incomplete because it only applies to ceramic tiles which are normally made using a press molding process but when making sanitary ware products such products are made using a slip casting method.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARLOS LOPEZ whose telephone number is (571)272-1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

² Assuming that applicant is acting under the duty of candor and good faith.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carlos Lopez/
Primary Examiner
Art Unit 1791